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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,309	02/21/2002	Gary John Corey		9106

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02/21/2003

Mr. Gary John Corey
21445 Bundy Canyon Road
Wildomar, CA 92595

EXAMINER

PALADINI, ALBERT WILLIAM

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,309

Applicant(s)

COREY, GARY JOHN

Examiner

Albert W Paladini

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) Or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing

subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In the section entitled "DETAILED DESCRIPTION OF THE INVENTION" on pages 4 and 5, there is no actual description of the inventions elements or operation. The description merely explains what the "Multi-Axes Tool Compensation" may be capable of doing.

For example, lines 12-15 on page 4 state "Using these defined methods of my invention for multi-axes tool compensation, the machine operator now has a pre-defined method to assign 3D and 5-axis tool characteristics at the CNC controller." This is an objective, but the apparatus and the method of performing this objective are not described.

Lines 16-19 on page 4 state The CNC machine operator does not require the assistance of the CNC programmer to re-create a brand new CNC G code Program with new tool information and definitions when a change is made." Here again, no apparatus or methodology is provided to perform the function.

It is also noted here that no description of figure 1 is provided.

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The specification must enumerate the elements of the invention, and explain how these elements work in concert to perform the desired function. It may also be useful to provide drawings of the invention to clearly explain the verbal description. This specification makes assertions about the possible capabilities of the invention, but does not provide a description of how to make or use the invention.

Appropriate correction and clarification is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting elements and essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary elements and structural connections. See MPEP § 2172.01.

Claims 1-5 and 8 recite potential capabilities or intended use of the invention, the claims do not recite the elements contained in the invention or the essential structural cooperative connections between the elements needed to achieve the capability stated.

For example, claim 1 recites "Multi-Axes Tool Compensation technology handles all tool compensation internal to the CNC controller." There is no recitation which describes the elements which constitute the "Multi-Axes Tool Compensation technology, or how these elements work together to perform the function recited. The same is true of claim 2-5 and 8.

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Claim 6 recites "Multi-Axes Tool Compensation has been in development and field use since 1991 by my customers." This information may be appropriate for the specification, but it should not be claimed since it does not describe the invention.

Claim 7 recites "I, Gary John Corey, solely invented Multi-Axes Tool compensation technology based on research I conducted as a CNC machinist." This also is not valid as a claim, since it does not describe an invention or inventive step. Any statement of ownership is contained in the Declaration.

Section 2106 (i) from the Manual of Patent Examination Procedure is reproduced below. This explains that a recitation of the intended use of the invention is not sufficient to describe the invention.

2106 (i) Intended Use or Field of Use Statements

Claim language that simply specifies an intended use or field of use for the invention generally will not limit the scope of a claim, particularly when only presented in the claim preamble. Thus, Office personnel should be careful to properly interpret such language. *Walter*, 618 F.2d at 769, 205 USPQ at 409 (Because none of the claimed steps were explicitly or implicitly limited to their application in seismic prospecting activities, the court held that "[a]lthough the claim preambles relate the claimed invention to the art of seismic prospecting, the claims themselves are not drawn to methods of or apparatus for seismic

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prospecting; they are drawn to improved mathematical methods for interpreting the results of seismic prospecting."). Cf. **Alappat, 33 F.3d at 1544, 31 USPQ2d at 1558.** When such language is treated as nonlimiting, Office personnel should expressly identify in the Office action the claim language that constitutes the intended use or field of use statements and provide the basis for their findings. This will shift the burden to applicant to demonstrate why the language is to be treated as a claim limitation.

The portion of the Manual of Patent Examining Procedure which describes the required content of the claims is reproduced below.

"608.01(i) Claims [R - 3]

37 CFR 1.75. Claims

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

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(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (See § 1.58(a).)

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

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(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

**>(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.<"

Appropriate correction and clarification is required.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

In Claim 8, the Applicant states “Multi-Axes Tool Compensation has been in development and field use since 1991 by my customers.” Since the Application was filed on February 21, 2002; the invention has been in public use for more than one year prior to the date of application for patent in the United States.

8. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: A detailed description of how, when, and to whom this invention was made available.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Relevant Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Link (4608747) discloses a controller for a multi-axes lathe using a CNC controller which has a safety partition to protect the operators when the work spindle is in the working position.

Schulz (6022132) discloses a method and apparatus for programming a multi-axes tool using encoders on each axis. A probe, with outputs to transducers, mounted in the spindle defines the desired cutting path.

Kamiguchi (6167325) discloses a multi-axes tool controller with a data correction method which compensates for the difference between an actual machining position, and the command position.

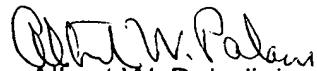
Hammerle (6225771) discloses a probe chord error compensation tool for use with a CNC processor and a multi-axes tool.

10. Any inquiry concerning this communication or earlier communication from the examiner should be direct to Albert W. Paladini whose telephone number is (703) 308-2005. The examiner can normally be reached from 7:30 to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Leo P. Picard, can be reached on (703) 308-0538. The official fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239, and after final faxes should be directed to (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

February 14, 2003


Albert W. Paladini
Primary Examiner
Art Unit 2125